

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

Status

As is correctly indicated on the Office Action Summary, Claims 1-21 are pending. Claims 2-11, 13, 14, 16, 17, 19, and 20 have been withdrawn from consideration. Claims 1, 12, 15, 18, and 21 stand rejected. Acknowledgment has been made to a claim for foreign priority under 35 U.S.C. § 119 (a) - (d) or (f) and all certified copies of the priority documents have been received.

Summary of Amendments

By the foregoing amendments, Claims 1, 12, 15, 18, and 21 have been amended to correct minor, typographical, and/or linguistic errors. Support for these amendments may be found in previously-presented Claims 1, 12, 15, 18, and 21. No new matter has been added.

Also by the foregoing amendments, Claim 22 has been added. Support for Claim 22 may be found at least at Page 8, Paragraph 0020 of the Specification. No new matter has been added.

Drawings

Form PTO 948 indicates that the Draftsperson objects to Figure 4 because the numbers and reference characters are not plain and legible and that the Examiner may require corrected drawings, if necessary.

Should the Examiner consider such correction necessary, Applicants respectfully request an indication of any such necessity in the next Official Action.

Election/Restriction

Applicants respectfully maintain their position that examining Groups I-V together poses no undue burden on the Examiner. Applicants appreciate the Examiner's reasons for alleged undue burden: an indication of what the M.P.E.P. should state and the status of PTO resources.

However, the M.P.E.P. sets forth the procedures which are to be followed when examining applications. The recently-revised (latest revision occurring in February 2003) M.P.E.P. continues to state that "a reasonable number of ... nucleotide sequences" are permitted in a single application and that "normally ten sequences constitute a reasonable number" (emphasis added).

While Applicants empathize with the Examiner's plea for clarification and/or revision of the M.P.E.P. and for increased resources, Applicants again respectfully request examination of Groups I-V together, as no such actions have occurred.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1, 12, 15, 18, and 21 were rejected under 35 U.S.C. § 112, First Paragraph as purportedly lacking sufficient written description and as not being enabled. *See Official Action Pages 2-7, ¶¶ 2-5.* These rejections are respectfully traversed.

Not to acquiesce in the Examiner's rejections, but solely to facilitate prosecution, Applicants have amended Claims 1, 12, 15, 18, and 21 and have added Claim 22 to better define Applicants' invention. These claims now specify that the isolated nucleic acid sequences correspond to SEQ ID NO:1; to SEQ ID NO:1 which has had no more than 5 nucleotide additions, deletions, or substitutions; to sequences which hybridize under stringent conditions¹ to SEQ ID NO:1; and to sequences with 90% homology thereto.

Applicants believe that these amendments have rendered moot the notion that Applicants were not in possession of the claimed invention and that one of skill in the art could not make or use Applicants' invention. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, First Paragraph, rejections against Claims 1, 12, 15, 18, and 21.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1, 12, 15, 18, and 21 have been rejected under 35 U.S.C. § 112, Second Paragraph, as purportedly indefinite. *See Pages 7-8, ¶¶ 5-6, of Action.* This rejection is respectfully traversed.

¹ Applicants wish to draw the Examiner's attention to Pages 10-11 of the Specification, Paragraphs 0026-0027, which describe "stringent conditions" — "Southern hybridization was performed in a solution of 5 x SSC, 0.5% SDS, 5-Derhardt's solution and 500 µg/ml Salmon sperm DNA at 50°C or 65°C ..."; "Hybridization and washing were executed under high stringency conditions at 65°C as described above."

Not to acquiesce in the Examiner's rejections, but solely to facilitate prosecution, Applicants have amended Claims 1, 12, 15, 18, and 21. Applicants believe these amendments render moot the outstanding 35 U.S.C. § 112, Second Paragraph rejections.

Rejection Under 35 U.S.C. § 101

Claim 1 was rejected under 35 U.S.C. § 101 as purportedly directed to non-statutory subject matter. *See Page 8, Middle ¶, of Action.* This rejection is respectfully traversed.

Not to acquiesce in the Examiner's rejection, but to solely to facilitate prosecution, Applicants have amended Claim 1 to specify that the nucleotide sequence is "isolated." Applicants believe that this amendment has rendered moot the outstanding 35 U.S.C. § 101 rejection.

Rejections Under 35 U.S.C. § 102(b)

Claims 1 and 12 were rejected under 35 U.S.C. § 102(b) as purportedly anticipated by GenBank Accession Number AB026837 to H. Yang *et al.* ("Yang"). This rejection is respectfully traversed.

While something was submitted to PLANT MOLECULAR BIOLOGY on April 28, 1999, it is not known what was submitted and, in any event, Yang was not *published* until December 19, 2000. Because Yang's publication occurred less than one year before Applicants' filing date, Yang is not an appropriate § 102(b) publication.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection against Claims 1 and 12.

Rejection Under 35 U.S.C. § 103(a)

Claims 1, 12, 15, 18, and 21 were rejected under 35 U.S.C. § 103(a) as alleged by unpatentable over Yang in view of A. Christensen et al., 5 TRANSGENIC RESEARCH 213-218 (1996) ("Christensen"). This rejection is respectfully traversed.

Because Yang is not a proper 35 U.S.C. § 103(a) publication, as explained above, Applicants maintain that the rejection over Yang in view of Christensen has been obviated.

CONCLUSION

From the foregoing, further and favorable consideration in the form of a Notice of Allowance is respectfully requested and earnestly solicited.

In the event that there are any questions relating to this response, or the application in general, it would be greatly appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,
BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: _____


Erin M. Dunston
Registration No. 51,147

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: May 5, 2003